

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

MAC & JACK'S BREWERY INC.,

Plaintiff,

- against -

AMERICAN CIDER COMPANY, LLC,

Defendant.

Case No. 19 Civ.

**COMPLAINT FOR TRADEMARK
INFRINGEMENT, TRADE NAME
INFRINGEMENT, AND FALSE
DESIGNATION OF ORIGIN**

Jury Trial Demanded

Plaintiff Mac & Jack's Brewery Inc. brings this complaint against Defendant American Cider Company, LLC, and alleges as follows:

NATURE OF ACTION

1. This is an action for trademark infringement, trade name infringement, unfair competition, and false designation of origin under the Lanham Act, 15 U.S.C. § 1051 *et seq.*, and the common law of New York, arising out of Defendant's use of the trademark MACKJAC for hard cider, which is confusingly similar to and infringes Plaintiff's trademark and trade name MAC & JACK'S, used in connection with beer. Despite having been notified by Plaintiff that its use of the infringing MACKJAC trademark is likely to cause confusion, Defendant has refused to cease its use of its infringing trademark, and continues to use it in connection with sales of its competing products.

PARTIES

2. Mac & Jack's Brewery Inc. is a Washington corporation doing business as Mac & Jack's Brewing Company ("Mac & Jack's"), with its principal place of business in Redmond, Washington, which brews and sells craft beer under the MAC & JACK'S trademark and trade name.

3. American Cider Company, LLC (“American Cider”) is a New York limited liability company, with its principal place of business in Orchard Park, New York. American Cider sells hard cider under the trademark MACKJAC.

JURISDICTION AND VENUE

4. This Court has jurisdiction over this action pursuant to 28 U.S.C. §§ 1131, 1138(a), 1138(b), and 15 U.S.C. § 1121 because it arises under the Lanham Act, 15 U.S.C. §§ 1051 et seq. Jurisdiction over the New York state law claims is also appropriate as these claims are so related to the claims brought under the Lanham Act that they form part of the same case or controversy, and hence fall within the scope of this Court’s supplemental jurisdiction pursuant to 28 U.S.C. §§ 1338(b) and 1367.

5. This Court has personal jurisdiction over American Cider because it is selling hard cider under its infringing trademark in this District.

6. Venue is proper in this District pursuant to 28 U.S.C. § 1391(b) because a substantial part of the events giving rise to Mac & Jack’s claims occurred in this District, and because American Cider is subject to personal jurisdiction in this District.

MAC & JACK’S AND ITS TRADEMARK AND TRADE NAME

7. Mac & Jack’s was founded in 1993 by Mac Rankin and Jack Schropp, and is still owned and operated by them. Mac & Jack’s brews craft beers and sells them in kegs, bottles and cans and sells them under its trademark MAC & JACK’S.

8. Mac & Jack’s has used “Mac & Jack’s Brewing Company” or “Mac & Jack’s” as its trade name since at least as early as its founding in September 1993.

9. Mac & Jack’s has sold beer under the MAC & JACK’S trademark since at least as early as April 12, 1994.

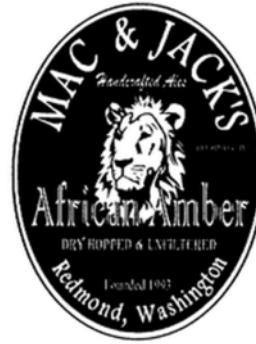
10. Mac & Jack’s and its MAC & JACK’S brand beers have been featured prominently in and recognized by numerous consumer and trade publications.

11. Beers that Mac & Jack's sells under its MAC & JACK'S trademark have consistently won high scores and awards in tastings conducted at competitions and by industry publications.

12. Mac & Jack's has promoted and advertised beer sold under its MAC & JACK'S trademark.

13. As a result of Mac & Jack's' long history of use of its MAC & JACK'S trademark in connection with beer, the high quality of that beer, and Mac & Jack's' marketing and promotion, as well as the public acclaim and press coverage that its beer has earned, the MAC & JACK'S trademark and trade name are widely recognized throughout the United States and have become associated with Mac & Jack's beer. The MAC & JACK'S trademark and trade name therefore symbolize valuable goodwill and reputation.

14. Mac & Jack's has registered two stylized depictions of its MAC & JACK'S trademark with the U.S. Patent and Trademark Office, as U.S. Trademark Registrations Nos. 2,262,652 and 2,307,017, depicted below:



15. Copies of the registration certificates for U.S. Trademark Registrations Nos. 2,262,652 and 2,307,017 are attached as Exhibits A and B. These registrations are valid, subsisting, and incontestable under the provisions of the Lanham Act, 15 U.S.C. § 1065. As a result, U.S. Trademark Registrations Nos. 2,262,652 and 2,307,017 constitute conclusive evidence of the validity of the registered trademarks, of Mac & Jack's ownership of those marks, and of Mac & Jack's exclusive right to use the marks in commerce.

AMERICAN CIDER'S WRONGFUL CONDUCT

16. On information and belief, American Cider began selling hard cider under the trademark MACKJAC in 2017.

17. American Cider is using the trademark MACKJAC in connection with the sale of hard cider in kegs, bottles and cans in commerce that may lawfully be regulated by Congress.

18. On information and belief, American Cider is selling hard cider under the MACKJAC trademark in the states of New York, Massachusetts, Connecticut, Rhode Island, Delaware, Pennsylvania, Maryland, Ohio, Michigan, Minnesota, and Florida.

19. American Cider has registered the domain <mackjachardcider.com> and has a website at www.mackjachardcider.com at which it advertises and promotes its hard cider under the MACKJAC trademark.

20. American Cider filed an application with the United States Patent and Trademark Office (“PTO”) on February 11, 2017, seeking to register the mark MACKJAC HARD CIDER in connection with hard cider. On December 2, 2017, the PTO issued a final action refusing to register MACKJAC HARD CIDER on the grounds that it creates a likelihood of confusion with the MAC & JACK’S trademarks claimed in U.S. Trademark Registrations Nos. 2,262,652 and 2,307,017. In its final action, the PTO found that the trademark MACKJAC HARD CIDER was “nearly identical in appearance, sound, commercial impression and connotation” to the MAC & JACK’S trademarks claimed in U.S. Trademark Registrations Nos. 2,262,652 and 2,307,017. Specifically, all these marks “share the similar, fundamental elements of ‘MAC(K)’ and ‘JAC(K)’ for related goods and services” and thus are “extremely similar.” In addition, the PTO noted that beer and cider often are sold by the same company and in the same channel of trade, and concluded that cider and beer are considered “related” when evaluating whether the marks are similar and therefore likely to create confusion.

21. American Cider has abandoned its application to register MACKJAC HARD CIDER.

22. American Cider's use of the MACKJAC trademark has already caused confusion. Mac & Jack's received a telephone call inquiring about the MACKJAC hard cider. On the social media website and mobile application UNTAPPD, consumers who have drunk MACKJAC brand hard cider have posted comments and reviews about the cider on the portions of the UNTAPPD site that relate to Mac & Jack's beers. There is no question that hard cider and beer are sold in the same channels of trade to the same customers. Mac & Jack's has been asked by distributors to provide hard cider. Menu boards posted by restaurants and bars have listed MACKJAC hard cider on a list of beer products.

23. On September 14, 2018, Mac & Jack's informed American Cider that use of the MACKJAC trademark in connection with hard cider creates a likelihood of confusion with the MAC & JACK'S trademark and demanded that American Cider cease and desist from use of the MACKJAC trademark. American Cider has refused to do so, and continues to use the MACKJAC trademark.

FIRST CAUSE OF ACTION
Trademark Infringement, 15 U.S.C. § 1114

24. Mac & Jack's realleges and incorporates by reference the preceding allegations set forth in Paragraphs 1 through 23, as if fully set forth herein.

25. American Cider's use of the trademark MACKJAC in connection with hard cider is likely to cause confusion and mistake as to the origin and source of American Cider's hard cider, and as to an association or affiliation between hard cider sold by American Cider and beer sold by Mac & Jack's. As a result, American Cider's use of the MACKJAC trademark infringes the MAC & JACK'S trademark claimed by U.S. Trademark Registrations Nos. 2,262,652 and 2,307,017 in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114.

26. American Cider's use of the confusingly similar trademark MACKJAC has been deliberate and willful, and with actual knowledge of Mac & Jack's rights in the MAC & JACK'S trademark.

27. Mac & Jack's has no adequate remedy at law and, if American Cider's wrongful use of the MACKJAC trademark is not enjoined, Mac & Jack's will suffer irreparable harm and injury to its goodwill and reputation.

SECOND CAUSE OF ACTION
Trademark and Trade Name Infringement, Unfair Competition,
and False Designation of Origin, 15 U.S.C. § 1125(a)(1)(A)

28. Mac & Jack's realleges and incorporates by reference the preceding allegations set forth in Paragraphs 1 through 27, as if fully set forth herein.

29. American Cider's use of the trademark MACKJAC violates Section 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A), because that use is likely to cause confusion and mistake as to the origin, sponsorship, or approval of hard cider offered and promoted by American Cider, including as to whether that hard cider originates from or is sponsored or approved by Mac & Jack's.

30. American Cider's use of the confusingly similar trademark MACKJAC has been deliberate and willful, and with actual knowledge of Mac & Jack's rights in the MAC & JACK'S trademark and trade name.

31. Mac & Jack's has no adequate remedy at law and, if American Cider's wrongful use of the trademark MACKJAC is not enjoined, Mac & Jack's will suffer irreparable harm and injury to its goodwill and reputation.

THIRD CAUSE OF ACTION
Common Law Trademark Infringement under New York Common Law

32. Mac & Jack's realleges and incorporates by reference the preceding allegations set forth in Paragraphs 1 through 31, as if fully set forth herein.

33. As a result of Mack & Jack's hard work and investments in producing, providing and promoting its Products, Mack & Jack's has built-up valuable good will in the MACK & JACK'S trademark. As such, the MACK & JACK'S trademark has become associated with its Products, and has come to symbolize the reputation for quality and excellence of the Mack & Jack's Products.

34. American Cider's unauthorized use of the MACKJAC Mark is likely to and does permit American Cider to pass off its infringing products to the general public to the detriment of Mac & Jack's and the unjust enrichment of American Cider. Such acts by American Cider have caused and continue to cause confusion as to the source and/or sponsorship of American Cider's infringing products.

35. As a direct and proximate result of American Cider's conduct, Mack & Jack's has suffered damage to its valuable trademark in an amount to be ascertained at trial.

36. Mack & Jack's does not have an adequate remedy at law, and will continue to be damaged by American Cider's sale of its infringing products unless this Court enjoins American Cider from such business practices.

THIRD CAUSE OF ACTION
Common Law Unfair Competition under New York Common Law

37. Mac & Jack's realleges and incorporates by reference the preceding allegations set forth in Paragraphs 1 through 36, as if fully set forth herein.

38. As a result of Mack & Jack's hard work in producing, providing and promoting its products, Mack & Jack's has built-up valuable good will in its MACK & JACK's trademark. As such, the MACK & JACK'S trademark has become associated with its products, and has come to symbolize the reputation for quality and excellence of Mack & Jack's products.

39. American Cider's acts have misled and continue to mislead and deceive the public as to the source of its infringing products, permit and accomplish passing off of the infringing products as those of Mack & Jack's, and falsely suggest a connection with Mack & Jack's.

40. Therefore, American Cider has committed unfair competition in violation of New York common law.

41. As a direct and proximate result of American Cider's conduct, Mack & Jack's has suffered damage to its valuable trademark in an amount to be ascertained at trial.

42. Mack & Jack's does not have an adequate remedy at law, and will continue to be damaged by American Cider's sale of the infringing products unless this Court enjoins American Cider from such fraudulent business practices.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Mac & Jack's prays for relief against Defendant American Cider as follows:

1. Entry of preliminary and permanent injunctions enjoining American Cider and its agents, employees, successors and assigns, and all persons acting in concert with them, from using in any manner the trademark MACKJAC or any other trademark confusingly similar to the MAC & JACK'S trademark and trade name;
2. Ordering American Cider to deliver up to Mac & Jack's for destruction all goods, signs, advertisements, literature, business forms, cards, labels, packages, wrappers, pamphlets, brochures, receptacles, and any other written or printed material in its possession or under its control which contains or encompasses the trademark MACKJAC, or any colorable imitations thereof;
3. Ordering American Cider to transfer to Mac & Jack's the domain <mackjachardcider.com> and to refrain from use of any domain name including "mackjac" or any phonetic equivalent thereof;
4. Ordering American Cider to file with this Court and serve on Mac & Jack's counsel within thirty (30) days after the Court's issuance of a judgment, a report setting forth in detail the manner and form in which American Cider has complied with Paragraphs 1 and 2 of Mac & Jack's Prayer for Relief;
5. Awarding compensatory damages sustained by Mac & Jack's and profits earned by American Cider as a result of the acts complained of herein pursuant to federal and state law, to be trebled in accordance with 15 U.S.C. § 1117;
6. Awarding Mac & Jack's its attorneys' fees pursuant to 15 U.S.C. § 1117, and other applicable federal and state laws;

7. Awarding Mac & Jack's interest, costs, and such other relief as the Court may deem just and equitable.

Dated: New York, New York
January 31, 2019

Respectfully submitted,

DAVIS WRIGHT TREMAINE LLP

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Attorneys for Mac & Jack's Brewery Inc.

DEMAND FOR JURY TRIAL

Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Mac & Jack's hereby demands a trial by jury.

Dated: New York, New York
January 31, 2019

Respectfully submitted,

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